REMARKS

Applicant hereby traverses the rejection of record and requests reconsideration and withdrawal of such in view of the remarks contained herein. Claims 1-18 are pending in this application, claims 1-6 and 13-18 are allowed, claims 7 and 9-11 are rejected, and claims 8 and 12 are objected to.

Rejection Under 35 U.S.C. § 103(a)

Claims 7 and 9-11 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,907,742 to Johnson et al (hereinafter "Johnson") in view of U.S. Patent No. 5,424,537 to Lehman et al (hereinafter "Lehman").

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art cited must teach or suggest all the claim limitations. *See* M.P.E.P. § 2143. Without conceding that the second criteria is satisfied, the Applicant respectfully asserts that the Examiner's rejection fails to satisfy the first or third criteria.

Lack of Motivation

In the Current Action, the Examiner opines that Johnson and Lehman "are combinable because they are in the similar problem area of image scanner calibration." *See* Current Action, paragraph 3. Applicant respectfully points out that "to support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *see* M.P.E.P. §§ 706.02(j), 2142; quoting *Ex parte Clapp*, 227 U.S.P.Q. 972, 973 (Bd. Pat. App. & Inter. 1985).

As an initial matter, Applicant points out that the Examiner's mere statement does not suffice as to why it would have been obvious to combine the cited references. The

Examiner's conjecture does not reveal any suggestion or motivation, explicit or implicit, in the references themselves or to one or ordinary skill in the art to combine those references. *See* M.P.E.P. § 2143.01. Applicant further points out that Johnson and Lehman are not in the "problem area of image scanner calibration" as the Examiner opines. Rather, the problem solved by Johnson is keeping a cathode fluorescent lamp warm while extending the life of the lamp. *See* Johnson col. 1 lines 46-50. In accomplishing this task, Johnson employs a lamp control scheme where lamp current is varied over time according to desired output; also, the lamp output is monitored by a sensor circuit. *See* Johnson Abstract. As such, "scanner calibration" is not the problem solved by Johnson. Lehman is related to a rotary scanner, having both linear and logarithmic mode static and dynamic calibration, to quickly calibrate the scanner. *See* Lehman Abstract. Therefore, Johnson and Lehman do not share the same "nature of the problem to be solved." *See* M.P.E.P. § 2143.01.

Failure to Teach or Suggest Every Claim Element

Claim 7 recites "adjusting the gains globally for the full calibration scan when the difference between the partial calibration scan and the full calibration scan is less than a predetermined amount." The Examiner acknowledges that Johnson does not teach or suggest this element. *See* Current Action, paragraph 3. However, the Examiner points to Lehman, at various citations, to satisfy this element. *Id.* Applicant respectfully points out that Lehman teaches a pre-scan calibration which occurs before taking data from a document. *See* Lehman at col. 2, lines 62-68. A second "line" calibration is performed at the beginning of each line scan of the document. *See id.* Lehman teaches adjusting gain and bias converters "at the start of each line scan...and adjusts the gain and bias converters 72, 74 in accordance with the differences." *See id.* at col. 11, lines 17-25. A calculated correction dG is added to converter 72 to "establish the requisite correction for the data that follows on the scan line." *See id.* at col. 11, lines 32-35. Lehman does not teach adjusting the gains globally for the full calibration scan when the difference between the partial calibration scan and the full calibration scan is less than a predetermined amount. Accordingly, the combination of Johnson and Lehman does not teach or suggest at least the above-recited element of claim 7. Thus, the Examiner's proposed combination fails to teach or suggest every element of Applicant's invention. Therefore, Applicant requests reconsideration and withdrawal of the U.S.C. § 103(a) rejection of record.

Claims 9-11 depend from claim 7. As such, claims 9-11 inherit each element from claim 7. As shown above, the Examiner's proposed combination fails to teach or suggest each element of Applicant's invention. Therefore, claims 9-11 each set forth elements not taught or suggested by the Examiner's proposed combination; and, are allowable at least for the reasons set forth above with respect to claim 7. In view of the above, Applicant respectfully requests that the Examiner withdraw the rejection of claims 7 and 9-11 under 35 U.S.C. § 103(a) and pass these claims to issue.

Conclusion

Applicant thanks the Examiner for the indication that claims 1-6, 8, and 12-18 contain allowable subject matter. In view of the above, Applicant believes the pending application is in condition for allowance. Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 08-2025, under Order No. 10008017-1 from which the undersigned is authorized to draw.

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as Express Mail, Airbill No. EV568255665US in an envelope addressed to: MS Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Date of Deposit: March 22, 2006

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Respectfully submitted,

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